

**REMARKS****Status of Claims; Amendment**

Prior to the amendment herein, claims 52 – 111 were pending in the application. Claims 70 – 72, 74 – 76, 94, 103, 105, 106, and 108 – 111 are hereby amended; and claims 58 – 63 and 85 - 93 are hereby cancelled, without prejudice and without disclaimer of subject matter.

Support for the amendment may be found throughout the specification as originally filed, including the Figures and the claims; and in particular at paragraphs [0049] – [0060], and in Figures 6 - 9.

No new matter is added by the amendment.

Applicant notes, for the Examiner's information, that the claims presented herein correspond to claims allowed in a corresponding Japanese application (serial number provided in table below).

**Disclaimer of Prior Statements and Amendments**

The claims, as presented herein, may be broader in some respects than claims previously presented. Applicant intends that the claims now pending be interpreted under the ordinary interpretation understood in the art. Accordingly Applicant expressly rescinds, and no longer intends that the claims be limited by, any and all assertions, statements, arguments, amendments or other actions previously made in this application, and/or any application whose file history is appropriate for use in interpreting any patent issuing on this application, that might be taken to be a surrender or disclaimer of any subject matter from the scope of any claim. No such assertion, statement, argument, amendment, or other action should be taken as a surrender or disclaimer from, and may not be used to interpret, any claim of this application, or any claim of any patent to which such applications' file histories may be pertinent.

Applicant intends, and expressly requests, that the Application be presented and examined *de novo*. Accordingly, Applicant urges the Examiner to make a thorough and

diligent search of the prior art with respect to each and every claim presented herein. Applicant requests that the Examiner reconsider any previous surrender, disclaimer or characterization of claims, and that he reconsider any prior art that may have been avoided or intended to be avoided by such surrender, disclaimer or characterization.

**Objection to Specification; Rejections under 35 USC § 101**

At paragraphs 2 and 3 of the Detailed Action the Examiner has objected to the specification as failing to provide proper antecedent basis for claims 58-63, 70-75, 85-93, and 103-111, and in the alternative has rejected those claims as directed to non-statutory subject matter under 35 USC 101.

Applicant respectfully traverses both the rejection and the objection: the subject matter of the claims is disclosed in such manner that any person of ordinary skill in the art would understand that proper antecedent basis is provided within the specification. Moreover, the affected claims clearly recite patentable devices, memories, and non-transient computer-readable media.

However, in the interest of advancing the application as rapidly as possible, Applicant has hereby cancelled claims 58 – 63 and 85-93, and amended claims 70-75 and 103-111. Both the cancellation and the amendment are made without prejudice, for the sole purpose of advancing examination at this time.

Applicant believes that such cancellation and amendment moots both the objection and the rejection, and requests reconsideration and allowance of the amended claims.

**Claims 52-75: rejections under 35 USC § 103**

At pages 3 – 11 of the Detailed Action the Examiner has rejected claims 52-75 as obvious over Wagner (US 2004/0155908) in view of Canfield (US 2004/0056893).

Applicant respectfully traverses. The cited references fail to teach or suggest each element of the claims, whether considered alone or in combination; and they teach away from each other and Applicant's claimed invention. Specifically:

- As acknowledged by the Examiner, the cited portions of Wagner and Canfield fail, whether considered alone or in combination, to teach or suggest at least the claimed limitation of visually modifying a displayed icon to include a character representing a count of a plurality of different messaging correspondents from whom messages have been received. The cited references are concerned primarily with a number of new messages, without regard to the correspondents from whom the messages have been received, or the number of such correspondents from whom messages have been received and remain unread. To track messages by correspondent in the manner claimed, rather than simple numbers of messages received, is novel, is significantly different from what was done before, and in the context of wireless devices and the cited art is counterintuitive.
- Canfield does not teach or suggest methods, devices, or other solutions suitable for implementation on wireless communications devices, such as mobile PDAs. Canfield is concerned solely with desktop-type large screen devices having access to virtually unlimited screen space and processing power. As such, Canfield teaches away from Applicant's invention.

Applicant notes that both Wagner and Canfield qualify as prior art against the application herein, if at all, solely under 35 USC 102(e). While Applicant submits that the claims as presented distinguish Wagner and Canfield on their merits, Applicant respectfully and expressly reserves all right to establish prior invention in order to establish that neither Wagner nor Canfield is valid prior art against this application or the claims presented herein.

#### Legal Standard

In order to establish a case of obviousness, "the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be determined; and the level of ordinary skill in the art resolved. Against this background the obviousness or non-obviousness of the subject matter is determined. Such secondary factors as commercial success, long felt but unrecognized needs, failures of others, etc., might be utilized to give light to the circumstances surrounding to origin of

the subject matter sought to be patented." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007), citing *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

In order to reject a claim based on a combination of references, it is explained at MPEP 2143 (citing the Supreme Court in *KSR v. Teleflex*), that "Office personnel must resolve the Graham factual inquiries...

Then, Office personnel must articulate the following:

(1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference;

(2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely performs the same function as it does separately;

(3) a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable; and

(4) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

*KSR*, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950).

"[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *KSR*, 82 USPQ2d at 1396.

MPEP 2143 further notes that if "any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art."

*KSR* further explains that even where (as is not the case here) all of the claimed elements may be found in the prior art, the teaching-suggestion-motivation test provides useful insights in making obviousness determinations: a patent composed of several

elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art. It can be important to identify a reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does. Inventions usually rely on building blocks long since uncovered, and claimed discoveries almost necessarily will be combinations of what was, in some sense, already known. The determination whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue should be made explicit.

Applicant respectfully reminds the Examiner also that determinations of obviousness are not to be based on hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention, as noted in, for example, *ATD Corp. v. Lydall, Inc.*, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998).

### Analysis

For purposes of this rejection, Claim 52 is representative. Claim 52 recites a method of providing notifications of unread messages on a wireless communication device. The method comprises displaying at least one icon relating to electronic messaging on a graphical user interface of the wireless communication device and, in response to receiving messages from a plurality of different messaging correspondents, visually modifying at least one displayed icon include a count of different messaging correspondents from whom one or more of the electronic messages have been received and remain unread.

Claims 53-57 depend from claim 52. Claims 64-69 recite corresponding computer-readable memories. Claims 70-75 recite corresponding wireless communication devices.

At page 4 of the Detailed Action, the Examiner has acknowledged that Wagner does not disclose 'in response to receiving at least one of the plurality of electronic messages, visually modifying at least one displayed icon relating to electronic messaging to include a numeric character representing a count of the plurality of different messaging

correspondents for which one or more of the electronic messages have been received and remain unread,' as claimed by Applicant.

However, the Examiner notes, "in the same field of invention" Canfield discloses tracking a number of new, unread messages. In doing so, the Examiner cites to paragraph [0054] of Canfield.

With respect, (a) Canfield is not in the same field of invention as Applicant's claims; and (b) as Applicant and the Examiner have previously agreed with respect to Wagner, counting a number of new, unread messages is not the same as, or for present purposes analogous to, counting a number of correspondents from whom messages which remain unread have been received. To the extent that Canfield and Wagner teach counting of messages, they teach away from Applicant's claims.

Counting unread messages is not the same as counting correspondents

As is well understood by those skilled in the relevant arts, and was particularly understood by such persons as of the effective filing date of the application herein, counting a number of messages received by a device which have not yet been read is very different from tracking a plurality of different correspondents from whom messages have been received, and presenting for a user's reference a number of such correspondents from whom messages have been received and remain unread. Both the mechanics of making such a determination and the use that may be made of such information are very different; and they both respond to and enable different patterns of communication, particularly by users of wireless devices.

In order to maintain such counts communications applications must track, count, and otherwise process different types of information. Merely counting a number of unread messages, regardless of source, is typically a simple matter of incrementing a counter variable each time a new message is received.

Counting a number of different correspondents from whom messages have been received, and remain unread, on the other hand, is significantly more involved: using, for example, contemporary techniques, each incoming message must be parsed for a correspondent's identity; parsed identities must be compared to a list of correspondents

from whom messages have previously been received; redundant entries must be ignored (at least for present purposes); a count of distinct correspondents must be maintained; and, as messages are accessed and read, the corresponding correspondent must be identified and the list of correspondents associated with unread messages must be adjusted as appropriate. If no further messages from that correspondent remain unread, then the correspondent must be removed from the count; if further messages remain, then the correspondent must continue to be counted.

Where such counts are maintained for multiple messaging applications, the problem can be geometrically compounded.

As is further understood by those skilled in the relevant arts, tracking and presentation of such information can be of immense value to users of wireless communications devices, particularly where (as here) correspondent information can be tracked and displayed separately for each of a plurality of messaging applications. For example, for users of IM, SMS, and other types of messaging applications, it is often more important to track a number of distinct correspondents from whom messages have been received, rather than the number of individual communications that have been received.

For example, it is well known that many users of IM, SMS, and other messaging applications send multiple individual messages to each other; sometimes the messages are related to a common topic, and sometimes not. For example, an IM or SMS user might inquire about a single subject multiple times; and the same user might ask a number of unrelated questions. In some cases, those from to whom such a proliferation of messages are addressed need not be concerned to read each message as it is received. However, it may be critical to look for even a single message received from another correspondent, such as a child travelling between school and home. By displaying the number of distinct correspondents from whom messages have been received, Applicant's claimed invention opens new possibilities for users of such communications.

Moreover, as those skilled in the arts understand, in the context of wireless communications devices it is counterintuitive to place any further burden on an operating system which is typically subject to significant restraints in power supply (e.g.,

battery life), processing power, memory, communications bandwidth, and display space. Thus a designer of such devices would not have been motivated to put them to the extra work of identifying and tracking numbers of distinct correspondents, and maintaining lists of such correspondents dynamically.

However, as the inventors herein realized, by expending such resources and modifying an icon associated with a corresponding communications application, as claimed, they could allow a user to very efficiently track sometimes crucial information while making very efficient use of display resources, and significantly reducing input, output, display, and other processing tasks that previously were required for the users to obtain and track such information.

As noted above, the Examiner has acknowledged that the cited portions of Wagner and Canfield fail, whether considered alone or in combination, to teach or suggest at least this feature of Applicant's claims. The cited references are concerned primarily with a number of new messages, without regard to the correspondents from whom the messages have been received, or the number of such correspondents from whom messages have been received and remain unread.

Applicant notes, for the sake of completeness and in the interest of advancing the application without delay, that at paragraph [0052] Canfield describes a conversation counter 650 displayed on IM interface 525 for the purpose of providing information relating to the concurrent IM sessions, such as the total number of concurrent or new IM sessions. Applicant further notes that for present purposes the counting of distinct IM sessions is closely analogous to counting numbers of distinct messages: the processes are involved are much simpler than tracking and displaying information relating to distinct correspondents, and none of the advantages described above relating to tracking of distinct correspondents is retained: again, for example, the advantage of being able to know that a new correspondent has attempted to communicate can be of great importance, and it is lost if simple numbers of current or new IM sessions is tracked. Applicant notes, for example, that a single correspondent can initiate an unlimited number of new IM sessions, just as he/she can send any number of e-mails or



other types of messages. Applicant's claimed solution of tracking distinct correspondents provides unique and unobvious advantages.

Far from being obvious, Applicant's claimed solutions are deceptively elegant and powerful, particularly when viewed in the context of device designs and methodology at the time the application herein was filed.

*Canfield is not in the same field of invention, and teaches away from Applicant's claims*

Not only does Canfield fail to teach or suggest the limitations of Applicant's claims; to the extent that it teaches, it teaches away from Applicant's invention, in a different field of communications: Canfield is concerned with processing and displaying information solely on desktop-type large-screen devices having relatively unlimited screen space and supported by relatively unlimited processing power. Canfield does not teach or suggest methods, devices, or other solutions suitable applicable to the problems faced by Applicant, or suitable for implementation on wireless communications devices, such as mobile PDAs.

In stating that Canfield discloses, "in the same field of invention," the limitations of Applicant's claims, at page 5 of the Detailed Action the Examiner points to Canfield's paragraph [0026]. At that location, the Examiner notes, Canfield states that "in another implementation, such devices [as a mobile telephone 192, a PDA 193] may themselves include the functionality of the general purpose computer 170 and operate as the client device 120."

This reference, however, is merely empty boilerplate patentese. Canfield provides no guidance whatever, and certainly no enabling disclosure, as to how one skilled in the relevant arts might implement the processes it teaches on a small screen device such as a wireless communication device. Through 18 columns of text and 17 sheets of drawings, Canfield describes user interface screens that could only meaningfully be implemented on large screen devices such as those depicted in Canfield's drawings. Nowhere does Canfield acknowledge, much less address, special problems associated with communicating information on wireless devices, and particularly small-screen wireless devices.

As is well understood by those skilled in the relevant arts, desktop and other fixed computer systems such as those addressed by Canfield are typically not subject to processing, communications, power, memory, or display limitations such as those faced in wireless (and particularly-small screen) systems. With relatively unlimited display space, power supply, memory, and processing power, information can be processed in ways that are much less efficient than those typically required for wireless devices.

By teaching solutions such as those shown on the large-screen displays depicted in each of its relevant figures, Canfield teaches away from Applicant's claimed invention.

**Claims 76-111: rejections under 35 USC §§ 102 and 103**

At pages 11 - 16 of the Detailed Action the Examiner has rejected claims 76-111 as anticipated by Wagner, or obvious over Wagner (US 2004/0155908) in view of Canfield (US 2004/0056893).

Applicant respectfully traverses. Neither Wagner nor Canfield teaches or suggests each element claimed; and each of them teaches away both from the invention claimed and from each other. Specifically:

- Neither Wagner nor Canfield, alone or in combination, teaches or suggests at least the claimed limitation of visually modifying a displayed icon to include a count of unread electronic messages concurrently with a text identifier associated with a correspondent from whom the at least one of the plurality of electronic messages was received.
- As noted above, Canfield does not teach or suggest methods, devices, or other solutions suitable for implementation on wireless communications devices, such as mobile PDAs. Canfield is concerned solely with desktop-type large screen devices having unlimited screen space and processing power.

Applicant reiterates that both Wagner and Canfield qualify as prior art against the application herein, if at all, solely under 35 USC 102(e). While Applicant submits that the claims as presented distinguish Wagner and Canfield on their merits, Applicant

respectfully and expressly reserves all right to establish prior invention in order to establish that neither Wagner nor Canfield is valid prior art against this application or the claims presented herein.

### Legal Standard

#### *Anticipation*

A claim is anticipated if, and only if, each and every element set forth in the claim is either expressly or inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). All elements of the claim must be shown in the single reference, *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Moreover, a patent claim "cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled." *Elan Pharm., Inc. v. Mayo Found. for Med. Educ. & Research*, 346 F.3d 1051, 1054 (Fed. Cir. 2003); *Rasmusson and Reynolds v. SmithKline Beecham Corp.*, case 04-1191, -1192 (Fed. Cir. 2005).

As noted in *Richardson v. Suzuki*, 15 USPQ.2d 1913 (cited at MPEP 2131.01), "The identical invention must be shown in as complete detail as is contained in the claim."

#### *Obviousness*

The legal standard for obviousness is set forth above.

### Analysis

For purposes of this response, Claim 76 is representative. Claim 76, as rewritten for clarity, recites a method of providing notifications of unread messages on a wireless communication device. The method comprises visually modifying at least one displayed electronic messaging icon to include a count of a plurality of unread electronic messages which remain unread; and displaying concurrently with the visually-modified icon a text identifier associated with a correspondent from whom the at least one of the plurality of electronic messages was received.

Claims 77-84 depend from claim 76. Claims 85-102 recite corresponding computer-readable memories. Claims 103-111 recite corresponding wireless communication devices.

The claims have been rewritten to clarify that the visually-modified icon is displayed concurrently with the text identifier as shown, for example, in Figures 6, 7, and 8. No such methods or devices are disclosed or suggested by the cited references.

For clarity, Applicant notes that to say that the visually-modified icon and text identifier are shown concurrently means that at some point in time both items are displayed on the same interface screen, as shown for example in Figures 6, 7, and 8.

The passages of Wagner cited by the Examiner suggest the display of various items, but are silent as to the possibility of any of them being concurrently displayed. Moreover, it is not at all clear that Wagner is suggesting the display of an identifier of a correspondent from whom a message has been received in conjunction with an application icon; and no such thing is taught in an enabling way. Rather, the passage relied upon by the Examiner for establishing this proposition (paragraph [0080]) appears to suggest that some vague (and certainly undisclosed) information pertaining to a correspondent might be displayed in some vague (and undisclosed) manner:

[0080] In addition, the user action proxy 612 can interpret a combination of service activities to mean a particular event. That is, the user action proxy 612 monitors the services of each user and notices particular patterns that may occur within the services. When such patterns are detected, the user action proxy 612 can notify the user that the user should potentially take action regarding the pattern. For example, a user may have a note in their "to-do" list on their calendaring application that says "Call Bob." In addition, the user may have an appointment with Bob at 3:00 p.m. stored in the user's calendar. Then, for example, Bob may call the user and leave a voice mail for the user. In this example, the user action proxy 612 will notice that Bob is a common theme within the services and applications, and as such, may send the user an alert indicating something important may be occurring regarding Bob.

A suggestion in this context that "the user proxy 612 will notice that Bob is a common theme within the services and applications, and as such, may send the user an alert indicating something important may be occurring regarding Bob" does not amount to an enabling disclosure that an identifier associated with a sender of unread messages may

be displayed together with an icon, in the manner claimed by Applicant. There is no suggestion that it might be advantageous to provide such information in conjunction with an icon showing a number of unread messages, and no teaching of any manner of doing so.

Thus Wagner anticipates none of claims 76 – 111.

To the extent that it teaches communications processes, Canfield teaches away from both Applicant's claimed innovation and from Wagner.

Wagner is concerned with providing modified navigation techniques for a variety of mobile applications, including news services, etc. It appears to suggest a number of distinct, independent means of imparting different forms of information. It does not teach or suggest Applicant's elegant, claimed solutions regarding communications notifications.

Canfield, as noted above, is concerned with displays suitable for use with desktop-type large screens having relatively unlimited screen space and supported by relatively unlimited processing power. Canfield does not teach or suggest methods, devices, or other solutions suitable applicable to the problems faced by Applicant, or suitable for implementation on wireless communications devices, such as mobile PDAs, and particularly those incorporating small-screen displays.

By teaching solutions such as those shown on the large-screen displays depicted in each of its relevant figures, Canfield teaches away from Applicant's claimed invention.

### **Dependent Claims**

Claims 53-57, 59-63, 65-69, 71-75, 77-84, 86-93, 95-102, and 104-111 depend from claims 52, 58, 64, 70, 76, 85, 94, and 103 respectively, and are allowable for at least the reasons outlined above.

Applicant disagrees strongly with the characterization of the cited references relative to many of the dependent claims provided by the Examiner at pages 3 – 16 of the Detailed Action. However, in view of the clear patentability of each of the independent claims for

the reasons cited above, and in the interest of advancing the application without delay and in the clearest possible matter, Applicant defers at the present time from providing detailed arguments.

Applicant hereby expressly reserves all right to provide separate reasons for patentability of any or all of the dependent claims presented herein, if and as necessary or desirable in future.

### **Status of Related Applications**

The following US, foreign, and international patent applications are or may be considered to be related to the application herein. Relevant documents pertaining to such cases are being provided or have been provided in one or more separately-filed Information Disclosure Statements. The status of such applications, as currently understood by Applicant, is summarized in order to ensure that the Office is fully apprised of the current state thereof. In the event the Office has any questions about the identified cases, the Examiner is requested to call Applicant's representative at the number below.

Applicant respectfully reminds the Examiner that the claims herein correspond to claims allowed in the Japanese application. Relevant documents have previously been provided via Information Disclosure Statement.

Serial No.	Country	Status
2006-541762	Japan	Granted
0871404	Rep of Korea	Granted
200480039930.2	China	Registered
200810099973.X	China	Registered
3113/DELP/2006	India	Pending – in examination
04713831.8	EPO	Closed - divisionals filed
08168419.3	EPO	Pending – oral proceedings
10177958.5	EPO	Pending - search report received
10177959.3	EPO	Pending - search report received
07100038.7	Hong Kong	Pending – awaiting allowance in EPO
200603555-4	Singapore	Pending – awaiting allowance in US or EPO
200804162.6	Singapore	Pending – In examination

2,548,598	Canada	Pending – in examination
2,732,050	Canada	Pending - in examination
2,727,763	Canada	Pending - in examination
CA2004/000263	PCT	Expired (NPE entered as above)

**CONCLUSION**

Applicant believes that it has responded to each ground of rejection raised by the Examiner, and that for at least the reasons cited above the claims, as presented, are in condition for immediate allowance. Applicant respectfully requests reconsideration and immediate allowance of the claims.

Applicant believes that no fees other than a one-month extension of time are due in connection with the filing of this paper. In the event that the office determines that any further fee is due, Appellant requests that such fee be charged to its Deposit Account No. 195113.

Applicant is concerned to advance this application as quickly as is reasonably possible. Accordingly, Applicant respectfully reiterates its request that, in the event the Examiner has any further questions about this application, the Examiner call Applicant's attorney at the number provided below.

Respectfully submitted,

Dated: \_\_\_\_\_September 8, 2011\_\_\_\_\_

\_\_\_\_\_/matthew j. marquardt/\_\_\_\_\_

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